

Response to Applicant's Arguments

First, the last Office Action is herein being vacated in favor of the present Action since Applicant stated that the SPE had agreed to send a new Action out without the Applicant having to respond to the last Action pursuant to 37 CFR 1.111.

Second, Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Specification

The title of the invention, under 37 CFR 1.72, should not exceed 500 characters and should be brief and technically accurate.

Claim Status

Claims 1-9 and 11-20 and 24-26 are currently pending in the Application, while claims 10 and 21-23 have been canceled.

General Comments

Regarding claim 16, in the limitation "wherein the at least one e-mail address comprises at least one e-mail address of an acquaintance of the consumer", it appears that the acquaintance's e-mail address was not used in any meaningful way.

Further, it appears that there is nothing specific about a symbol in terms of shape, color or otherwise that helps identify or recognize a related advertisement as a rich advertisement, i.e. an advertisement having one or more selectable options reviewable upon

clicking on the symbol. In other words, clicking on a symbol or icon to reveal the one or more selectable options reads on the above limitation (See fig. 9 of the current drawings). In addition, although the Instant Application supports the above claim, however, it appears that the PGPUB version does not immediately support such claim language.

Claim Objections

Claim 26 is objected to because of the following informalities-

Concerning claim 26, “wherein the advertisement and the at least one request option is viewable after activation of the advertisement” should apparently be - wherein the advertisement and the at least one request option **are** viewable after activation of the advertisement- ,

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 (including dependent claims 2-9, 11-20 and 24-26) is rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter and non-functional descriptive material. Indeed, the claim features in the preamble “A **feature rich**

advertisement to be displayed on a consumer computing device, the feature rich advertisement comprising:”, which does not pertain to any of the well-defined statutory classes, i.e. a method, a system, an apparatus, a computer-readable medium and so on, and thus, the claim merely represents a collection of data or data per se, which is not statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 15 and 24 (including their dependent claims) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In fact, it appears that “...the advertisement is **generally positioned.....**” is not immediately supported in the specification as originally filed using the PG PUB version of the Instant Application (US20020120507A1). Further, the same remark holds true for “....**options generally hidden from the consumer**”.

Moreover, regarding claim 24, it appears that “wherein the activation of the advertisement comprises **the consumer mousing over the indicia or symbol**” is not immediately supported in the specification as originally filed. In other words, it appears that **the consumer mousing over the indicia or symbol** to activate the advertisement is not immediately supported in the specification as originally filed.

Regarding claim 26, although the disclosure as originally filed supports “**the ad space** and the at least one request option are viewable after activation of the advertisement”, it appears that the specification does not immediately support that “**the advertisement** and at least one request **are** viewable after activation of the advertisement” since that the **ad space** (i.e. location) is not the same as the **advertisement** (i.e. content displayed in the ad space).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 and 15 (including their dependent claims) are rejected under 35 USC 112(2) as being indefinite for reciting the adverb “**generally**”. For instance, in the limitation “...the advertisement is **generally positioned** with respect to browser content reviewable by a consumer;”, as featured in claim 1, it is unclear where and how the advertisement is displayed with respect to the browser content and the use of the adverb “**generally**” does help clarify that either. In other words, “**generally positioned**” does not immediately indicate where the advertisement is actually being displayed vis-à-vis the browser content. Further, the same rejection applies to “**options generally hidden**”. Here, it is unclear how often the related options are being hidden from or revealed to the user without the user clicking on the symbol.

Additionally claim 15 (including its dependent claims) are rejected under 35 USC 112(2) as being confusing or ambiguous. Indeed, the limitation “the requests being initially generally hidden from view, **but becoming visible when a consumer viewing said advertisement activates said advertisement**” appears to be confusing since not only the advertisement was already displayed or activated on the user’s computer, but also the requests or selectable options

are included with the symbol, not the advertisement and thus, they are hidden under the symbol and are only revealed or become visible when the user activates the said symbol. Further, the same rejection applies to claims 6 and 24-26.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-20 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wexler, USP 5,960,409.

As per claims 1, 3-9, 11-15, 17-20, 24 and 26, Wexler discloses a system and method for providing on-line third party accounting and statistical information is disclosed. **A third party accounting service receives a download request signal, from a client computer, ultimately intended for an advertiser Web site. The download request signal is generated when a user clicks on a banner displayed on a Web page of a frequently visited host Web site, wherein the web page content is generally positioned with respect to the banner ad (the request signal is a request for more information, such as a special offer, new product release, pricing, etc., from the advertiser).** The banner is published by the frequently visited host Web site for the benefit of the advertiser. The third party receives the download request since, rather than pointing to the advertiser Web site, the banner is configured to point to the third party Web

site. The third party Web site maintains a count of all received download request signals generated by clicking on the banner. Since an advertiser banner may be displayed at more than one frequently-visited Web site, the third party Web site further maintains a log containing the address of the frequently visited host Web site that displayed the banner that generated the click, as well as other information provided by the user Web browser. The third party sends a redirect signal to the user Web browser causing it to send a download request to the advertiser Web site. The advertiser Web site then downloads the information originally sought by the user to his Web browser. The third party accumulates and tabulates statistical information including the number of clicks on the advertiser banner, and data indicative of the effectiveness of the banner-publisher frequently-visited Web site as an advertising medium. Such information is provided to the advertiser and/or the banner publisher (See abstract).

In general, Wexler discloses an online accounting or auditing system for identifying an advertisement or banner Ban 1, from an advertiser Ban 1, having an inherent identifier (GUID or adGUID) associated with a unique referenced point <http://www.genesis.com/puba/ban1> representing a banner advertisement Ban 1 accessible at a web site or publisher A or Pub A.

Indeed, upon connecting to a global network or the Internet, a user using a remote computer can access a publisher's web site (Pub A) and click on a banner advertisement or Ban 1 from advertiser Ban 1 to finally be transported to the advertiser's web site where he can receive more information about an advertised item or even purchase the advertised item. The remote computer used by the user is identified as the computer that accesses the banner or Ban 1 at Pub A or publisher's web site and this information along with other information provided by the user's web browser and the web site address associated with Pub A

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are used by a third party to count the number of clicks or impressions on Ban 1 or banner advertisement at Pub A, compute other statistical report and measure the effectiveness of the system. Here, the dynamic IP address related to the user's remote computer during the connection to the Internet can be used as an ID or second GUID (userGUID) to identify the remote computer accessing the banner advertisement or Ban 1 at Pub A or an inherent logging indicium associated with the user, such as logging name and/or password or any other code, as commonly used in the art to help identify a user or his computer accessing an information server or web server on a network such as the Internet. **As appropriate, the third party accounting and statistical service 13 can define or record a user's click or impression or interaction on an advertisement or Ban 1 each time the advertisement or any other advertisement is served to the user connecting to a publisher's web site wherein the number of clicks is counted in order to measure the effectiveness of the system.** It is further contemplated here that an identification or third identifier GUID (impGUID) or any marker can be used by the third party accounting and statistical service 13 to register that, for example, Ban 1 receives a click from a particular remote computer used by a user, with a specific logging indicium, who accesses a web site with a given marker or indicium or URL address. Furthermore, these identifiers or markers or identifications or indicia or first GUID, second GUID and third GUID are internal operations handled by software and do not directly affect the process or system by which an advertisement banner is being displayed to a user accessing a web site and wherein a statistical report is being produced by a third party, as understood by those skilled in the art. Moreover, when the banner or advertising is represented by an identifier or hyperlink (indicia), the user has to click (mouse over) the indicia to access a related web site and read the

corresponding ad (See abstract; col. 5: 24 to col. 6: 19; claim 3).

Once a user is on-line, i.e., connected to the Internet through an Internet Service Provider (ISP), the link 11 to the Web site 5 of fig. 1 is established by "entering" the address, i.e., the uniform resource locator (URL), of the Web site 5 into the Web browser 3. Once the link 11 is established, the Web browser 3 sends a download request signal 11a to the Web site 5. In response, the Web site 5 downloads information, indicated by the reference numeral 11b, to the user's Web browser 3. The downloaded information includes a Web page 7 (requested content) having a banner 9. The banner 9 (ad) is an area of the Web page 7 that can be used to display logos (indicia or symbols), etc., that will hopefully entice a user reading the banner to obtain further information pertaining to the banner (col. 3: 46-58; col. 5: 29-31).

In short, the banner (i.e. advertising), having an advertising displayed thereon, describes an area of a Web page that can be used to display logos (symbols or indicia), etc., that will hopefully entice the reader to obtain further information pertaining to the banner. If so enticed, the reader can "click" on the banner, assuming the banner is a link, and follow the link to, for example, the Web site of the business "behind" the banner. The banner provides substantially more of an advertising presence to the advertiser than a directory listing, since, at least for a contracted period of time, the banner is conspicuously displayed on the Web page. Thus, regardless of a user purpose for visiting such a site, he may see the advertiser banner displayed (col. 1: 49-60; col. 5: 29-31).

See col. 1: 21-30; col. 2: 38-61; col. 3: 65 to col. 5: 23.

As per claims 1, 2 and 15, although Wexler discloses activating a logo (symbol or indicia) related to a banner or advertising to request more information, however, **he does not expressly teach that when the logo is activated by the user one or more options are revealed including providing the requested information to the user via the user's e-mail address if the e-mail option is selected.**

However, it is common practice in the art to deliver or transmit information to a user by regular mail via the post-office, fax and e-mail. For instance, requested information, including discount coupon, can be provided to a user who directly or indirectly requests the information, wherein the requested information is either displayed in real-time on the user's screen or e-mailed to the user via the user's recorded e-mail address (See WO 97/23838).

"Official Notice".

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the above disclosure ("Official Notice") into the Wexler's system so as to associate one or more selectable options including delivery options (i.e. mailing, faxing, e-mailing) with a logo or symbol (indicia), coupled to a banner or advertising, wherein the options are revealed when a viewer or reader (user) of the advertising activates the logo to request more information, and to provide upon receiving a signal or the e-mail selection option from the user, the requested information or further information, related to a presented advertising or promotion, to the user via e-mail, thereby

enabling the user or viewer of the banner or advertising to control what he wants to do with and how he wants to receive the requested information or further information related to the displayed banner or advertising by selecting at least one option, e.g. the e-mail delivery option, from a menu of revealed options, while providing in substantially real-time the requested (more) information, related to the featured or presented promotion or ad/banner, to the user instead of mailing the information, especially if the requested information is not readily available, and while enticing the user to acquire or purchase a product/service presented in the ad or banner.

As per claim 16, although Wexler discloses activating a logo (symbol or indicia) related to a banner or advertising to request more information, however, **he does not expressly teach that the e-mail comprises one e-mail address of an acquaintance of the user or consumer.**

However, it is common practice in the art to allow a user to send a content being consumed or read from a source or information of interest to a friend (acquaintance) via e-mail for marketing purpose. For example, a consumer buying a product, having a volume discount, sends e-mails to friends or family members to encourage them to join a co-op (pool) as participants such that the purchasing power of the unit or co-op is used to receive a group discount related to the product, thereby reducing the sales price of the item or product for the members of the co-op or unit (pool) (USP 6,101,484).

“Official Notice”.

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the above disclosure (“Official Notice”) into the Wexler’s system so as to associate one or more selectable options including delivery options (i.e. mailing, faxing, e-mailing) with a logo or symbol (indicia), coupled to a banner or advertising, wherein the options are revealed when a viewer or reader (user) of the advertising activates the logo to request that more information be sent to him and/or to a friend (acquaintance) via his e-mail address or the friend’s e-mail address respectively, thereby enabling the user or viewer of the banner or advertising to control what he wants to do with and how he wants to receive himself or to send to a friend the requested information (further information) related to the displayed banner or advertising by selecting at least one option, e.g. the e-mail delivery option, from a menu of revealed options, while providing in substantially real-time the requested (more) information, related to the featured or presented promotion or ad/banner, to the user and/or his friend instead of mailing the information, especially if the requested information is not readily available or it is time-sensitive, and while enticing the user to acquire or purchase a product/service presented in the ad or banner and to encourage his friend to do the same.

As per claim 25, Wexler does not explicitly disclose that the advertisement is at least partially covered by the at least one request option after activation.

However, fully covering, partially covering or not covering at all the advertisement (banner or advertising) when a request option is being activated is a matter of desires, which does not directly impact the utility or functionality of the system or process.

Thus, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to reach the above conclusion and realize that fully covering, partially covering or not covering at all the advertisement (banner or advertising) when a request option is being activated does not impact the utility or functionality of the system or process.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USP 5,959,621A to Nawaz discloses a system and method for dynamically displaying data items on a client computer. In one aspect of the invention, the client computer displays a graphical user interface having a windowing environment and a desktop. The desktop includes a ticker display pane for dynamically displaying the data items. The data items may contain hyperlinks so that a user has access to information on multiple server computers. The data items are displayed in a substantially continuous sequence and may be provided from Internet servers, Intranet servers, LAN servers, and/or the client computer itself (See abstract and fig. 3). **This reference can be used to reject the claims under 35 USC 103.**

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

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/J. J./

/Jean Janvier/

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